HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, Colorado 80527-2400

OIPE JC11
MAR 17 2005
PATENT & TRADEMARK OFFICE

PATENT APPLICATION

ATTORNEY DOCKET NO. 10003136-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Charles E. Schinner et al.

Confirmation No.: 3209

Application No.: 09/676,649

Examiner: Y.K. Aggarwal

Filing Date: 09/29/2000

Group Art Unit: 2615

Title: Digital Still Camera with Remaiing Picture Count Indication

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in ***triplicate*** is the Reply Brief with respect to the Examiner's Answer mailed on **01/26/2005**. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

(X) I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450. Date of Deposit: **03/14/2005**

OR

( ) I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number_____ on _____

Number of pages:

Typed Name: **Sherre Anne Treat**

Signature: Sherre Anne Treat

Respectfully submitted,

Charles E. Schinner et al.

By _____ 3-14-05

Michael H. Jester

Attorney/Agent for Applicant(s)
Reg. No. **28,022**

Date: **3/14/2005**

Telephone No.: **(619) 628-4598**

OIPE
MAR 17 2005
PATENT & TRADEMARK OFFICE

BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF APPEALS AND INTERFERENCES

In re Patent Application of:	)		
	)		
Charles E. Schinner et al.	)	Group Art Unit: 2615	
	)		
Serial No.: 09/676,649	)	Examiner:	Yogesh K. Aggarwal
	)		
Filed: September 29, 2000	)	Conf. No.:	3209
	)		
For: ***Digital Still Camera with Remaining Picture Count Indication***	)		

REPLY BRIEF

BOARD OF PATENT APPEALS & INTERFERENCES
Director for Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants, through their undersigned attorney, hereby submit this Reply Brief pursuant to 37 CFR §41.41 in response to the Examiner's Answer mailed January 26, 2005.

On pages 14 and 15 of his Reply Brief, the examiner argues that the control circuit of Shen et al. determines a remaining picture count based on a predetermined decrement number corresponding to an actual file size. Applicants respectfully disagree. Column 3, lines 32-34 and column 4, lines 20-25 of Shen et al. clearly indicate that the number of pictures that can still be taken is determined based upon a *predetermined standard image file size* for high resolution images and a *predetermined standard image file size* for low resolution images.

For the convenience of the examiner, salient portions of the text of Shen et al. are reproduced below.

> "The number of pictures that can be taken in each resolution is stored in a 4-bit serial EPROM 40 which is connected to the 8-bit microprocessing unit 28." (column 3, lines 32-34)

"In one embodiment of the present invention, the flash memory 32 can contain 8 high resolution pictures or 32 low resolution pictures." (column 3, lines 63-65)

"The microprocessing unit 34 can then compare the total number of pictures taken with a predetermined number to determine if another high or low resolution picture can be taken." (column 4, lines 25-28)

The microprocessing unit 34 of Shen et al. can only recognize, in advance of picture taking, that eight high resolution pictures or thirty-two low resolution pictures can be stored in flash memory 32 if the high and low resolution pictures have been assigned a predetermined standard image file size. This is the only way the microprocessing unit 34 can determine how many more picture at each resolution can still be stored in the flash memory 32.

As discussed in the background of Applicants' application, the actual size of the image files for pictures taken with a digital still camera varies greatly depending upon the subject, the level of data compression, and the picture resolution. There are drawbacks in basing a remaining picture count algorithm on a predetermined estimated maximum image file size, a predetermined estimated minimum image file size, or a predetermined estimated average image file size. (See page 2, lines 26-36)

On page 15 of the Examiner's Answer, the examiner states:

"[t]he MPU34 then compares the total number of pictures taken with a predetermined number which is the same as the actual file size of the image that would be just generated by the camera and determines if another high or low resolution image can be taken by decrementing that predetermined number (same as the actual file size of the image that would be just generated by the camera) in each resolution from the total number of images that had been taken for each resolution (col. 4 lines 17-35)."

The flaw in the examiner's foregoing statement lies is his equating of "a predetermined number" with "the actual file size of the image that would be just generated." As is well known to those skilled in the art of digital still camera design, it is not possible to accurately predict the precise size of an actual image file in advance since it depends upon the factors identified above, including the amount of detail in the object or scene of interest which has been photographed. A busy image, such as a close-up photograph of a flower, will have many more pixels than an image which has a large portion of blue sky. In the camera of Shen et al., the available capacity

in the flash memory 32, which is determined by the microprocessing unit 34 in Step 100, is only used: 1) to determine whether a high resolution image can be taken; 2) to determine whether a low resolution image can be taken; or 3) to automatically switch between resolution modes. Shen et al. does not teach that the available memory capacity can somehow be used to determine the remaining picture count. Moreover, even if there were such a teaching in Shen et al, the available capacity in the flash memory 32 is not the same as an actual image file size of an image just generated as required by Applicants' claims.

For the foregoing reasons, it is submitted that the examiner has failed to make out a *prima facie* case of anticipation of independent Claims 1, 11, 20 and 21. Moreover, the obviousness rejections of the remaining dependent claims should be reversed since they rely upon the improper foundation that each of their parent claims lack novelty over Shen et al.

The examiner's rejections should be reversed.

No additional fee is believed to be due in connection with the filing of this Reply Brief. However, if any fee is due, please charge the same to Deposit Account No. 08-2025.

Respectfully submitted,

3-14-05

By: Michael H. Jester
Attorney for Applicants
Registration No. 28,022